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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/850,982	05/08/2001	Pierre Marraccini	88265-4025	4965

7590 08/27/2003  
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200 Park Avenue  
New York, NY 10166

EXAMINER

KALLIS, RUSSELL

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 08/27/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/850,982

Applicant(s)

MARRACCINI ET AL.

Examiner

Russell Kallis

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1,4-7,9,11-15 and 19-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 4-6,21 and 22 is/are allowed.
- 6) ☐ Claim(s) 9,11,12,15,23-25 is/are rejected.
- 7) ☐ Claim(s) 1,7,13,14,19,20,26 and 27 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### **DETAILED ACTION**

The Claims as amended and newly presented are being examined to the extent that they read on the elected SEQ ID NO: 1 encoding SEQ ID NO: 2 as elected without traverse in paper No. 15.

Rejection of Claims 1-7 and 9-15 under 35 U.S.C. 112, first paragraph, written description, is withdrawn in view of Applicant's amendments and arguments.

Rejection of Claims 1-5, 9-13, and 15 under 35 U.S.C. 112, second paragraph, as being indefinite is withdrawn in view of Applicant's amendments.

Rejection of Claims 1-2, 6-7, 9, 10, and 12-15 under 35 U.S.C. 102(b) is withdrawn in view of Applicant's amendments and arguments.

Rejection of Claims 1-2, 6-7, 9, 10, and 11-15 under 35 U.S.C. 103(a) is withdrawn in view of Applicant's amendments and arguments.

### ***Claim Rejections - 35 USC § 112***

Claims 9, 11-12 and 15 remain and new Claims 23-25 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for SEQ ID NO: 1 and microbial cells transformed therewith, does not reasonably provide enablement for transformed plant cells and plants comprising said polynucleotides or dietary, cosmetic or pharmaceutical compositions.

Applicant has not addressed the Examiner's enablement rejection with respect to unpredictability in modification of metabolism in transformed plants and unpredictability in making pharmaceutical or other bioactive compositions given the lack of guidance in the specification. The specification has not taught how to use transformed plants, or how to make safe and effective bio-active compositions containing the nucleic acid molecule.

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The claims are deemed free of the prior art, given the failure of the prior art to teach or reasonably suggest an isolated polynucleotide from coffee encoding a polypeptide having mannanase activity comprising at least SEQ ID NO: 2, a polynucleotide at least 90% homologous to SEQ ID NO: 1, or microbial or plants hosts transformed therewith.

Claims 1, 7, 13-14, 19-20 and 26-27 are objected to for reading on non-elected sequences.

Claims 4-6 and 21-22 are allowed.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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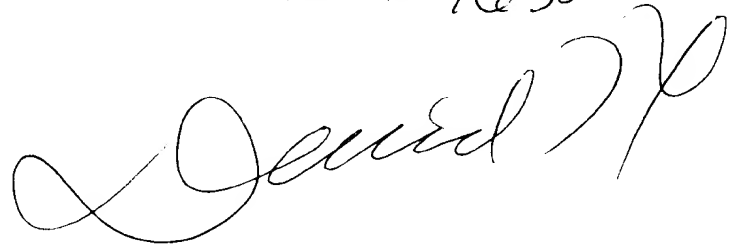
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell Kallis whose telephone number is (703) 305-5417. The examiner can normally be reached on M-F 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on (703) 306-3218. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0198.

Russell Kallis Ph.D.  
August 14, 2003

DAVID T. FOX  
PRIMARY EXAMINER  
GROUP 180-1638

A large, stylized handwritten signature in black ink, appearing to read "David T. Fox", is written over the printed name and title.